

ESTTA Tracking number: **ESTTA663064**

Filing date: **03/25/2015**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	85760361
Applicant	Moustache, Inc.
Applied for Mark	MOUSTACHE
Correspondence Address	ANGELO J BUFALINO VEDDER PRICE PC 222 N LASALLE ST , STE 2400 CHICAGO, IL 60601 UNITED STATES abufalino@vedderprice.com
Submission	Consent Agreement, in response to Order dated February 27, 2015 remanding the file back to the Examining Attorney for consideration.
Attachments	20150318 executed Consent Agreement FGO440CAN.PDF(4483983 bytes )
Filer's Name	Angelo J. Bufalino
Filer's e-mail	abufalino@vedderprice.com
Signature	/angelo bufalino/
Date	03/25/2015

## **CONSENT AGREEMENT**

This CONSENT AGREEMENT under TMEP § 1207.01(D)(viii) (the "Agreement") is entered into as of this 18<sup>th</sup> day of March, 2015, by and between Moustache Inc., a New York corporation with a principal place of business at 265 East 10th Street, New York, New York 10009 and Moustache Lex LLC, a New York limited liability company with an address of 1121 Lexington Avenue, New York, New York 10029 (collectively "Moustache"), and Figaro's Italian Pizza, Inc., an Oregon corporation ("Figaro's Pizza"), with its principal place of business at 1500 Liberty Street, Suite 160, Salem, Oregon 97302.

WHEREAS, Moustache owns all rights in U.S. Application Serial No. 85/760,361 for the mark MOUSTACHE for restaurant services in International Class 043;

WHEREAS, Figaro's Pizza owns all rights in U.S. Registration No. 3,741,557 for a moustache design (the "Moustache Logo") for retail pizza store services featuring baked and unbaked pizza, breadsticks, calzone, lasagna and soft drinks in International Class 035 and restaurant and take-out restaurant services featuring baked and unbaked pizza, breadsticks, calzone, lasagna and garlic bread, cookies and soft drinks, all for customer take-out or consumption on premises in International Class 043;

WHEREAS, on October 22, 2012, Moustache filed Application Serial No. 85/760,361 based on actual use claiming a date of first use of commerce and first use of at least January 1, 1989;

WHEREAS, Moustache's application to register MOUSTACHE was rejected by the United States Patent and Trademark Office in an Office Action dated September 10, 2014, citing likelihood of confusion with U.S. Registration No. 3,741,557 having a date of first use and first use in commerce of March 28, 2008 at the earliest;

WHEREAS, Moustache filed Cancellation No. 92060742 against U.S. Registration No. 3,741,557 on January 23, 2015;

WHEREAS, the parties believe and agree that the design differences between these marks will not give rise to the mistaken belief that such services emanate from the same source;

WHEREAS, the parties believe and agree, as evidenced by peaceful coexistence of these marks over the last six years, and by the established experience in the channels of trade, that the two brands of services are directed toward different sophisticated potential consumers;

WHEREAS, the parties believe and agree that their respective marks will not give rise to the mistaken belief that such services emanate from the same source;

WHEREAS, the parties believe and agree, on the basis of their actual experience in their respective industries, that their respective customers and potential customers render a high degree of care in selecting the services they purchase;

WHEREAS, the parties believe and agree that, notwithstanding the fact that the first use of Moustache's mark MOUSTACHE in 1989 predates the first

use of Figaro's Pizza's Mustache Logo mark & design in 2008, there was no likelihood of confusion or actual confusion created by these marks, and that therefore confusion is unlikely;

WHEREAS, the parties believe and agree, on the basis of their actual experience in the marketplace, that these marks can coexist peacefully without actual confusion for actual customers and potential customers; and

WHEREAS, the parties believe and agree, on the basis of their actual experience in their respective industries, that there will be no likelihood of confusion, mistake, or deception as a result of the respective use and registration of their respective marks.

NOW THEREFORE, intending to be legally bound, in consideration of the promises and mutual obligations and undertakings set forth herein, the parties agree as follows:

1. Figaro's Pizza hereby consents to the registration on the Principal Register of Application Serial No. 85/760,361 and any other application for the mark MOUSTACHE that Moustache may file.
2. Both parties will continue to use their respective marks in commerce.
3. Figaro's Pizza agrees that the registration of the mark MOUSTACHE by Moustache for restaurant services in International Class 043 is not likely to confuse the marketplace.
4. Neither Moustache nor Figaro's Pizza will interfere with the right of the other to use or register the marks at issue in this Agreement, including the



filing of a Petition for Cancellation, a Notice of Opposition with the Trademark Trial and Appeal Board, or any action for invalidation in the courts.

5. Upon execution of this Agreement, Moustache will submit this Agreement in connection with its U.S. Trademark Application Serial No. 85/760,361, and Moustache will endeavor, without opposition or interference from Figaro's Pizza, to obtain the issuance of Application Serial No. 85/760,361 and/or other application(s) for the mark MOUSTACHE.

6. Upon acceptance by the parties of this Agreement, Moustache and Figaro's will jointly move to dismiss Cancellation No. 92060742 against U.S. Registration No. 3,741,557.

7. On the basis of the foregoing Agreement, the parties' use of their respective marks will not be likely to cause confusion, to cause mistake, or to deceive.

8. In the unlikely event that the parties should learn in the future of any actual confusion on the part of the public as a result of their use of their respective marks, the parties agree to confer and to take all appropriate steps to alleviate any such confusion.

9. All provisions of this Agreement shall be severable. The validity of any provision shall not affect the validity of the remaining provisions. In the event of the invalidity of any provision, this Agreement shall be interpreted and enforced as if such provision were not contained herein.

10. This Agreement may be signed in counterparts and each copy shall be considered an original for all purposes.

11. This Agreement shall terminate if either party abandons the use of its mark in connection with the respective goods sold by the parties.

12. Each party shall have the right to assign its rights and obligations under this Agreement to a third party upon notice in writing to the other party.


13. This Agreement will be governed by New York law, without regard to its conflicts of laws rules.

SIGNATURE PAGE FOLLOWS

IN WITNESS WHEREOF, the parties have executed this Agreement to be effective the date first written above.

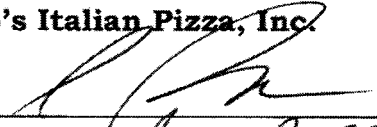
Date: 03-19-2015 2015

**Moustache, Inc.**

By:   
Name: SALAM AL-RAWI  
Title: Pres.

Date: March 18, 2015

**Figaro's Italian Pizza, Inc.**

By:   
Name: RON BERGER  
Title: CHAM/CEO